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Before the United States Patent and Trademark Office
Reply to Office Action

Mailing Date of Office Action:

Regarding:

Application Number: **10/805,077**
Filing Date: 20 March 2004
Applicant: David Scott Thompson
Title: Paging Unit, a System Including Paging Units and the Use of Those
Art Unit: 2173
Examiner: Ryan F. Pitaro
Agent's Docket No.: 04-167

Comments and Arguments

Claims 1-4 are being amended to address the 35 USC § 101 and the 35 USC § 112 concerns and the objection to claim 3.

The Carissimo reference (United States Patent Application Publication 2002-0105412) is not enabling. A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention. *In re Hoeksema*, 399 F.2d 269, 274, 158 USPQ 596, 601 (CCPA 1968). **MPEP § 2144.08**. Since Carissimo is used as the sole reference for rejection of claims 1, 2, 4, 6, 9, 12, and 15 based on 35 USC § 102(b), reconsideration of those rejections is requested. Since

Carissimo is used (in combination) for rejection of claims 3, 5, 7, 8, 10, 11, 13, 14, 16, 17, 18 and 19 35 USC § 103, reconsideration of those rejections is requested. Evidence of the fact that that reference is not enabling includes:

- 1) The office action (05 June 2002) on Application 09/777078 (the Carissimo application). A copy of a relevant portion of page 2 of that office action is copied below

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Devices; a receiver, a transmitter and a software programmer; are critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). That is; according to the specification, a receiver, a transmitter and a software programmer are not in one unit or a device.

- 2) A declaration by Brian Langford, dated 18 August 2005
- 3) A declaration by Daniel Orozco-Perez, dated 03 August 2005
- 4) A declaration by Paul C Haas, dated 10 August 2005
- 5) A declaration by Daniel James Minear, dated 11 August 2005
- 6) A declaration by Lawrence Benjamin Palmer, dated 12 August 2005
- 7) A declaration by Don Weerasiri, dated 15 August 2005
- 8) A declaration by Kenny G.O'Dell, dated 15 August 2005

9) A declaration by Robert DeBrecht, dated 16 August 2005

10) A declaration by Karl Wilhelm, dated 15 August 2005

11) A declaration by Greg Bohning, dated 17 August 2005

12) A declaration by Kevin Mitchell, dated 10 August 2005

The declarations are submitted with this transmission.

While applicant does not agree with every opinion of every person submitting a declaration, all we included to comply with to duty 37 CFR 1.56. Although no two persons submitting declarations agree fully on each detail, the over-all consensus of those submitted declarations is clear: Carissimo is not even close to enabling.

Also, Carissimo does not disclose (let alone enable) a graphical dedicated receiving unit.

- ☐ A graphical display is not mentioned in the disclosure
- ☐ The figures are far more suggestive of an alphanumeric display than a graphical display.
- ☐ The only hint of a graphical requirement in Carissimo (but not description) is the words "videos" and "movies" in examples of entertainment (paragraph [0008]). Carissimo's expression of a desire to entertain is not a disclosure of a means to do so.

Again, it is requested that rejections (Claims 1-19) based on Carissimo as a teaching of a graphical dedicated receiving unit be reconsidered.

In the rejection of claim 20 based on 35 USC § 102(b), and in the rejection of claims 18 based on 35 USC § 103, Harel (United States Patent 6366195) is cited as teaching a unit in "which said unit is capable of dynamically adjusting its transmission power, wherein, that dynamic adjustment of the transmission power is based, at least in part, on the strength of the signals sent by the base station and received by the unit." While Harel seemingly discloses dynamic adjustment of transmission power by a receiving unit, that adjustment is not based on the strength of the signal received by the receiving unit. The adjustment is seemingly based on information encoded in a digital signal sent the base which instructs the receiving unit about adjusting the transmission power of the receiving unit. Therefore, reconsideration of those rejections is requested.

In the rejection of claim 11 based on 35 USC § 103, Vasquez (United States Patent Application Publication 2004-0227617) is, accurately, described as teaching "at least one preset message when the unit is out of range." However, the cited portion of Vasquez discloses an audible message. Claim 11 includes "graphical dedicated receiving unit displays at least one." The cited portion of Vasquez does not disclose a device which

"displays." To clarify, claim 11 is being amended by inserting the word "visually" immediately before the word "display." Therefore, reconsideration of that rejection is requested.

In the rejection of claim 13 based on 35 USC § 103, Vasquez ([0039] lines 8-15) is said to teach "a marketing message displayed on at least one... unit promoting the establishment employing the system." However, the cited passage is silent about whether the promoted establishment is that employing the system. Therefore, reconsideration of that rejection is requested.

In the rejection of claim 14 based on 35 USC § 103, Vasquez ([0039] lines 8-15) is said to teach a system in which at least one marketing message displayed on the graphical display of at least one graphical dedicated receiving unit promotes the establishment other than that employing the system. However, the cited passage is silent about whether the promoted establishment is other than that employing the system. Therefore, reconsideration of that rejection is requested.

In the rejection of claim 16 based on 35 USC § 103, Showghi (United States Patent Application Publication 2003-0050854) is cited as teaching the use of synthesized frequency. The cited passage does not seem to include such a teaching. Therefore, reconsideration of that rejection is requested.

In the rejection of claim 16 based on 35 USC § 103, Showghi is said to teach a system in which the conveyor of the system is compensated, at least in part, by the rights involving advertising using the system. However, the "facility owners" of the cited passage of Showghi are not the same as the "conveyor" of claim 16. Therefore, reconsideration of that rejection is requested. The specification of the subject application indicates the meaning of conveyor:

[0045] The advertising revenue generating potential of the system could allow for establishments to be given, sold, lent the system or leased the system at reduced cost in exchange for the conveyor (giver, seller, lender or lessor) having advertising rights. Those advertising rights may be transferable.

The showing of a suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." *C.R. Bard, Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1352, 48 USPQ 2d 1225, 1232 (Fed. Cir. 1998). The showing of a suggestion, teaching, or motivation to combine the prior art references must be clear and particular. Broad statements about the teaching of multiple references, standing alone, are not evidence. *Dembiczak*, 175 F.3d at 1000, 50 USPQ2d at 1617. "The mere fact that a worker in the art could rearrange the parts of the reference device to meet the

terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device." *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984) "The combination of elements from non analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself." *In re Otiker*, 24 USPQ 2d 1443, 1446 (Fed. Cir. 1992). MPEP § 2144.04(VI)(C) , MPEP § 2142.

In the rejection of claim 13 and 14 based on 35 USC § 103, no motivation is cited in Carissimo or Vasquez for combining the teachings of those references in rejecting. No other reference is cited indicating such motivation.

In the rejection of claim 7, 8, 10 and 16 based on 35 USC § 103, motivation is cited in Carissimo or Showghi for combining the teachings of those references. No other reference is cited indicating such motivation.

Claim 11 is being amended by replacing "each" with "at least one." This is not in response to any objection or rejection in the office action.